

## REMARKS

With entry of the amendment, claims 1-6 and 22-56 are pending. In a telephone conference of May 26, 2004, Applicants provisionally elected Group I claims 1-6 and 22-28. Applicants affirm the election of Group I claims.

In the Office Action mailed June 14, 2004, claims 1-6 and 22-28 were rejected on various grounds, and claims 29-56 were withdrawn from consideration. Applicants have amended claims 1 and 3. The amendments are fully supported by the specification as originally filed and introduce no new matter.

In view of the amendments above and arguments below, Applicants respectfully request withdrawal of the rejections and allowance of the claims.

### Rejections under 35 U.S.C. 102(b)

Claims 1-4 were rejected under 35 U.S.C. 102(b) as being anticipated by Josephson (U.S. Patent No. 4,672,040). The Office Action asserts that Josephson teaches a method for isolating biological target material using silica magnetic particles. Applicants have amended claim 1 to clarify that the method of the invention employs particles capable of reversibly binding at least 2 micrograms of the biological target material per milligram of particles. Support can be found throughout the application (e.g., page 7, lines 19-25).

Applicants respectfully submit that the amendment to claim 1 overcomes the rejection of claim 1 and claims 2-4, which depend from claim 1.

### Rejections under 35 U.S.C. 103(a)

Claims 3, 5, and 22-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Josephson (U.S. Patent No. 4,672,040) and Gautsch et al. (U.S. Patent No. 6,613,895). Josephson was cited as teaching teaches a method for isolating biological target material using silica magnetic particles. The Examiner acknowledged that "Josephson does not teach silica magnetic particles capable of binding at least 2 micrograms of a biological target material."

The Examiner asserted that Gautsch et al. teaches silica particles capable of binding at least 2 micrograms of a biological target material, and cites to Column 4, lines 49-51 of Gautsch et al. Gautsch et al. suggests a kit for isolating nucleic acid molecules including *particulate glass in an amount sufficient to bind at least two to three micrograms of nucleic acid* (emphasis added). In contrast, independent claims 1 (as currently amended) and 22 are

drawn to a method that employs silica or siliceous oxide coated magnetic particles capable of binding 2 micrograms biological target material or plasmid DNA per milligram of particle.

Whereas claims 1 and 22, and their dependent claims 2-6 and 23-28 require particles having a minimum binding capacity expressed as a minimum mass of bound material per unit mass of particles, Gautsch et al. refers to a mass of particles sufficient to recover a minimum mass of nucleic acids. Gautsch et al. provides no teaching as to the mass of biological target material bound per unit mass of particles.


In view of the foregoing, Applicants respectfully submit that the claims are patentable over the cited art, and request withdrawal of the rejections and allowance of the claims.

Obviousness type double patenting rejections

Claims 1-6 and 22-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over U.S. Patent No. 6,027,945. Applicants respectfully traverse the rejection. However, in the interest of advancing prosecution, Applicants submit a terminal disclaimer. Applicants request withdrawal of the rejection and allowance of the claims.

This response is accompanied by Check No. 51461 in the amount of \$110.00 to cover the terminal disclaimer fee required under 37 C.F.R. 1.20(d). No other fee is believed due in connection with this submission. If a fee is owing, please charge such fee to Deposit Account No. 50-0842.

Respectfully submitted,



Jill A. Fahrlander  
Reg. No. 42,518

File No. 016026-9148-03  
Michael Best & Friedrich LLP  
One South Pinckney Street  
P. O. Box 1806  
Madison, WI 53701-1806  
(608) 257-3501